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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/606,482

06/26/2003

Pankai K. Mehrotra

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EXAMINER

SAVAGE, JASON L

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

03/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/606,482</p>	<p>Applicant(s) MEHROTRA ET AL.</p>	
	<p>Examiner JASON L. SAVAGE</p>	<p>Art Unit 1794</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 55.
- Claim(s) objected to: _____.
- Claim(s) rejected: 25-34, 56 and 57.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/KEITH D. HENDRICKS/
Supervisory Patent Examiner, Art Unit 1794

Continuation of 3. NOTE: The proposed amendment to claim 25 changing the lower bound for the heat treating temperature range to about 1600°C creates new combinations which had not previously been considered and would require further consideration and search.

Furthermore, although about 1600°C was recited as a limitation in claim 56 previously, the limitation would be considered new matter. Applicant's assertion that the limitation is supported since several mixtures disclose a temperature equal to 1650°C which clearly allow persons of ordinary skill in the art to recognize that applicants invented what is claimed by the claims is not persuasive. One of ordinary skill would not clearly envision 1650°C as being 'about 1600°C'. As such, the claim limitation in proposed claim 25 and previously presented claim 56 would be considered new matter. It is noted claim 56 is not an original claim. Proposed claim 57 would still be rejected as containing new matter. Applicant asserts the claim limitations are supported since an example falls within the limitations of the claim. This argument is not persuasive. Just because an example falls within a range does not provide support for an entire range. Applicant has not provided proof that the claimed range is supported in the Application as originally filed.

Continuation of 11. does NOT place the application in condition for allowance because: In light of the non-entry of the proposed Amendment, Applicant's arguments relying on the limitation of 1600 C with respect to the rejections over the prior art are not commensurate in scope with the claims.

Regarding Applicant's argument that the specification contains many descriptions that disprove the Examiner's position that heating a ground insert to the claimed temperature range after (emphasis added) the insert has been ground, the cited portions of the specification are not commensurate with that which is taught by Jindal. Jindal explicitly recites the cutting tool insert may be made by conventional ceramic powder processing techniques and densified by... pressure less sintering. The sintered (emphasis added) cutting insert of Jindal is considered equivalent to the heat treated insert claimed by Applicant. None of the cited examples in the specification make clear that the non-inventive embodiments were subjected to sintering either prior to or after (emphasis added) grinding. As such, Applicant has not met the burden of showing that the prior art product of Jindal does not necessarily or inherently possess characteristics of the claimed products.

Regarding Applicant's argument that Jindal's 'heat treatment step' occurs at 400 C and one could not properly expand the cleaning treatment to encompass a heat treating step with a temperature equal to 1600-2200 ; as recited above, the heat treatment step in Jindal being relied upon is the sintering step, not the cleaning step. As evidenced by Suzuki, it is well known that temperatures of 1700-1850 and 2000 C are used to sinter silicon nitride and silicon carbide materials such as those taught in Jindal.

Regarding the rejection over Jindal in view of Moriguchi. Applicant argues that the recited combination is improper since Moriguchi is drawn to an unground insert. However, as recited in the Final Rejection, both Jindal and Moriguchi are generally drawn to ceramic cutting inserts comprising silicon nitride based materials which are heat treated by sintering. As such, Applicant's assertion that the references are not combinable or that they are combined solely on the basis of hindsight reasoning is not persuasive.

Regarding the rejection of the claims over JP'174, as recited above, in view of the non-entry of the proposed Amendment, Applicant's arguments are not commensurate in scope with the claims.